

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNHARD LETTMANN

Appeal 2006-1487
Application No. 10/018,336
Technology Center 1700

Decided: September 29, 2006

Before PAK, WARREN and FRANKLIN, Administrative Patent Judges.

PAK, Administrative Patent Judge.

REMAND TO THE EXAMINER

This case is not ripe for review and is, therefore, remanded to the Examiner for appropriate action.

On May, 2005, the Appellant submitted a Brief, along with an appendix containing claims 1 through 11, 14, 15, 17 through 28, 33, 34, 36 and 30. In the Brief, the Appellant stated that “[t]his appeal is taken from the final rejection of claims 1-11, 14, 15, 17-28, 33, 34, 36 and 39 made in the Office Action mailed on November 18, 2004.” (Br. 1). The Appellant

also questioned the propriety of the Examiner's § 103 rejections of claims 1-11, 14, 15, 17-28, 33, 34, 36 and 39 set forth in the Final Office Action mailed on November 18, 2004 Br. 2-16).

In response, the Examiner mailed an Answer on August 23, 2005. The Answer set forth the following rejection:

Claims 1-11, 14, 15, 17-28, 33 and 36 are rejected under 35 U.S.C. [§] 103(a) as being unpatentable over Reusmann et al., U.S. Patent 6,403,701 in view of Kawakami et al., EP 0 081994.

According to the Examiner (Answer 3):

This appeal involves claims 1-11, 14, 15, 17-28, 33 and 36. Claim 39 is not being appealed. (Claim 39 is depending [sic., dependent] on claim 34. Claim 34 stands as [sic.] canceled.

The Examiner improperly indicated that claim 39 is not appealed.

Subsequent to the submission of the Answer by the Examiner, the Appellant filed a Reply Brief, along with an appendix containing claims 3, 18, 19, 21, 22, 25 and 26, on October 17, 2005. In the Reply Brief, the Appellant stated in the STATUS OF AMENDMENTS section of the Reply Brief (page 4):

Claims 1, 2, 4-11, 14-17, 20, 23-24, 27, 33, 36, 39, are hereby canceled. Entry of this amendment is hereby requested per 37 CFR [§] 41.33(b)(1)[(2004)].

The Appellant again asserted in the STATUS OF CLAIMS section of the Reply Brief (page 3) that:

Claims 3, 18-19, 21-22, and 25-26 are pending in the application. Claims 12, 13 and 29-32 were

withdrawn. Claims 1, 2, 4-11, 14-17, 20, 23-24, 27, 33-41 have been canceled.... Claims 3, 18-19, 21-22, and 25-26 are [now] being appealed...

The Appellant appeared to assert that the Reply Brief was necessitated by the Examiner's Answer of August 23, 2005 containing a new ground of rejection. (Br. 9).

37 CFR § 41.41(2004) states in relevant part:

- (a)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.
- (2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence...
- (b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

Yet, in the communication dated January 10, 2006, the Examiner merely stated:

The reply brief filed 10/17/2005 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

The Examiner did not notify the Appellant that his Reply Brief was not in compliance with 37 C.F.R. § 41.41(a)(2004). Nor did the Examiner state the status of the Amendment mentioned in the Reply Brief or respond to the Appellant's arguments directed to an allegedly new ground of rejection.

Thus, we remand this application to the Examiner to:

1) Notify the Appellant that the Reply Brief is not in compliance with 37 CFR § 41.41(a)(2004) so that he has an opportunity to comply with the Rule; and

2) Provide, upon compliance with Rule, a Supplemental Answer limited to the rejection of only those appealed claims and a complete response addressing any arguments directed to the appealed claims.

This application, by virtue of its “special” status, requires an immediate action on the part of the examiner. See *MPEP* § 708.01(8th Ed., August 2001). It is important that the examiner promptly inform the Board of any action affecting the appeal in this case (e.g., abandonment, issue, reopening prosecution).

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED
37 CFR § 41.50(a)

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